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EXAMINER	
DANNEMAN, PAUL	

ART UNIT	PAPER NUMBER
3627	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/688,094	KUMAR ET AL.	
	Examiner	Art Unit	
	PAUL DANNEMAN	3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 October 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-29* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-29* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This Office Action is in response to Applicants response filed on 29 October 2009.

2. Claims 1, 3, 10, 13, 15 and 22 have been amended.

3. Claim 29 is newly added.

4. Claims 1-29 are pending and have been examined in this Office Action.

Response to the Arguments

5. Applicants traverse the rejection of Claims 1-28 under 35 U.S.C. § 101, statutory type double patenting rejection over Claims 1-6, 8-18, 20-24 and 27-28 of Application 10688,425 as both applicants have been amended and are not coextensive in scope. After carefully reviewing the amended claims in both applications, the Examiner has been convinced that the scope of the amended claims does not support a "statutory type double patenting" rejection and will respectfully withdraw the rejection. A "non-statutory type double patenting" rejection will be entered.

6. Regarding the rejection of Claims 10, 11 and 12 under 35 U.S.C. § 101, the Examiner respectfully withdraws the rejection as the Applicants have amended Claim 10 to overcome the rejection.

7. Applicants' arguments regarding the combination of Knauss, Schwarzhoff, and XML have been fully considered, but are rendered moot based on the new grounds of rejection as shown below.

Double Patenting

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226

(Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

9. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. **Claims 1-29** are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6, 8-18, 20-24 and 27-29 of copending Application No. 10/688,425. Although the conflicting claims are not identical, they are not patentably distinct from each other because ***they are directed toward translating invoice data to an intermediate format between two or more applications***.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

11. **Claims 1-29** are rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson, US 7,099,350 B2.

Claims 1, 10-13 and 22:

With regard to the limitations:

- ***Receiving invoice adjustment information in an application-specific data object format from various software applications;***

- ***Receiving configuration information related to the software applications is received at a transport layer, and***
- ***The invoice adjustment information is comprised of an identification data element; invoice adjustment base data element; a billing data element; a status data element; and a list of invoice adjustment line item details data element;***
- ***Translating the invoice adjustment information into a common invoice adjustment data object format;***

Peterson in at least Column 2, lines 16-43 discloses that data transfer between dissimilar systems is often facilitated by the use of customized software applications known as **"adapters".** The adapters are used to extract data from the first system, convert the data into another intermediate format (e.g., EDI, XML) another adapter is used to convert the data in the intermediate format to the data format of the second system.

Peterson in at least Column 3, lines 15-29 discloses an invention consisting of a method and apparatus for converting data between two dissimilar systems (database structures). The method includes the step of first extracting data from a first system and converting that data into an intermediate format. The data in the intermediate format is then converted into a format compatible with the second database structure where the data is stored for use by the second system.

Peterson does not specifically disclose that the data being converted is invoice adjustment information per se, however in at least Fig.2 and Column 8, lines 1-52 Peterson provides an example where System A (transaction node 140) desires to order a particular product in a particular quantity from System B (transaction node 142). The data associated with the transaction or transactions would be assembled, in accordance with a pre-determined transaction profile as determined by the system beforehand and in accordance with a business relationship between the transacting parties, and forwarded to the appropriate location in the appropriate format to be received and processed by System B.

Therefore, it would have been obvious, at the time of the invention to one of ordinary skill to modify Peterson in a manner to pre-determine how two business entities would transact invoice adjustment information consisting of data elements (i.e. identification, base adjustment element, billing data, status data and line item detail) with the motivation to allow invoice adjustment information to be shared among interested business parties.

- ***Translating is comprised of accessing a first storing unit configured to store transformation information, wherein the first storing unit is coupled to the processor;***
- ***Accessing a second storing unit configured to store defined business processes, wherein the second storing unit is coupled to the processor; and***

Peterson in at least Column 3, lines 15-29 discloses an invention consisting of a method and apparatus for converting data between two dissimilar systems (database structures). The method includes the step of first extracting data from a first system and converting that data into an intermediate format. The data in the intermediate format is then converted into a format compatible with the second database structure where the data is stored for use by the second system.

- ***Using a business process controller configured to execute the business processes, wherein the execution is in response to predefined events.***

Peterson in at least Fig.2 and Column 8, lines 1-52 Peterson provides an example where System A (transaction node 140) desires to order a particular product in a particular quantity from System B (transaction node 142). The data associated with the transaction or transactions would be assembled, in accordance with a pre-determined transaction profile as determined by the system beforehand and in accordance with a business relationship between the transacting parties, and forwarded to the appropriate location in the appropriate format to be received and processed by System B.

Peterson in at least Column 14, lines 42-64 further discloses the use of "Extents" or software programs which are used to determine how to process data, extract the data from various

database tables, create intermediate tables and reassembling the data prior to transmitting the data to the appropriate destination. Peterson in at least Column 14, lines 14-41 further discloses that the tables are formed as the result of a transaction or other transactions.

Claims 2-9, 14-21 and 23-28:

Regarding the limitations:

- ***Interchanging invoice adjustment information between software applications,***
- ***Translating the invoice adjustment information into a format useable by the receiving software application,***
- ***Determining essential data elements from one format and converting to a another format,***
- ***Essential data elements include identification, invoice adjustment, billing, status, and a list of invoice adjustment line item detail elements.***

Peterson in at least Column 3, lines 15-29 discloses an invention consisting of a method and apparatus for converting data between two dissimilar systems (database structures). The method includes the step of first extracting data from a first system and converting that data into an intermediate format. The data in the intermediate format is then converted into a format compatible with the second database structure where the data is stored for use by the second system.

Peterson does not specifically disclose that the data being converted is invoice adjustment information per se, however in at least Fig.2 and Column 8, lines 1-52 Peterson provides an example where System A (transaction node 140) desires to order a particular product in a particular quantity from System B (transaction node 142). The data associated with the transaction or transactions would be assembled, in accordance with a pre-determined transaction profile as determined by the system beforehand and in accordance with a business relationship between the transacting parties, and forwarded to the appropriate location in the appropriate format to be received and processed by System B.

Therefore, it would have been obvious, at the time of the invention to one of ordinary skill to modify Peterson in a manner to predetermine how two business entities would transact invoice adjustment information consisting of data elements (i.e. identification, base adjustment element, billing data, status data and line item detail) with the motivation to allow invoice adjustment information to be shared among interested business parties.

- ***The invoice adjustment data uses extensible markup language format.***

Peterson in at least Column 9, lines 6-33 discloses that the conversion (translating) taking place could be as simple as converting data from an SML language to an XML language and it could also be utilized to translate between languages, or any other type of data information conversion.

Claim 29:

With regard to the further limitation of Claim 5:

- ***Specifying a level of compatibility with a data object format of a first application, wherein the determining the essential data elements facilitates achieving the specified level of compatibility.***

Peterson does not specifically disclose specifying a level of compatibility per se; however Peterson in at least Fig. 11 and Column 17, lines 17-32 discloses that the Extent used to export the data from the transaction table allows a system (node) to conduct its portion of the transaction in the predetermined manner as defined by the transaction profile. Not all of the necessary transaction information is contained here but, rather only the information or the process steps necessary to create and transmit the transaction packet from the system in the correct manner.

Peterson in at least Column 30, lines 23-64 discloses that the manner for converting data and information in one database to a master system is provided by the extensions referred to herein as "Extents" that provide a software program for retrieving data from the non-master database and formatting into a format compatible with the master system.

Therefore, it would have been obvious, at the time of the invention, to one of ordinary skill to modify Peterson with an "Extent" which is used to determine a level of compatibility and the

necessary data elements for achieving the level of compatibility specified for particular business transaction with the motivation to insure that all necessary transaction data is made available between business entities.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL DANNEMAN whose telephone number is (571)270-1863. The examiner can normally be reached on Mon.-Thurs. 6AM-5PM Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul Danneman/

Examiner, Art Unit 3627

6 February 2010

/F. Ryan Zeender/

Supervisory Patent Examiner, Art Unit 3627